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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,485	02/10/2004	Seiichi Katano	49987-1002	3224

29989 7590 10/17/2007  
HICKMAN PALERMO TRUONG & BECKER, LLP  
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SAN JOSE, CA 95110

EXAMINER
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TESLOVICH, TAMARA

ART UNIT	PAPER NUMBER
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2137

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10/17/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/776,485	<b>Applicant(s)</b> KATANO, SEIICHI	
	<b>Examiner</b> Tamara Teslovich	<b>Art Unit</b> 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 8, 9, 11 and 15-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8-9, 11, 15-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8.15.07</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This Office Action is in response to Applicant's Remarks and Amendments filed September 6, 2007.

Claims 1, 3, 9, and 11 are amended.

Claims 4-7, 10, 12-14 remain cancelled.

Claims 16-28 are new.

Claims 1-3, 8-9, 11, and 15-28 are pending and herein considered.

### ***Election/Restrictions***

Newly submitted claims 17-28 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

- I. Claims 1-3, 8-9, 11, 15-16, are drawn to the protection of MFPs through the monitoring or scanning of existing data, classified in class 726, subclass 25.
- II. Claims 17-19, are drawn to the protection of MFPs through scanning of incoming requests, classified in class 726, subclass 23.
- III. Claims 20-28, drawn to the protection of MFPs through the scanning of information sent from the MFP to other devices in the network, classified in class 726, subclass 3.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as within firewalls, particularly those protecting entire networks from rogue outsiders. See MPEP § 806.05(d).

Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as within firewalls, particularly those protecting entire networks from rogue outsiders. See MPEP § 806.05(d).

Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination III has separate utility such as the scanning of outgoing emails by company email servers. See MPEP § 806.05(d).

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 17-28 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Information Disclosure Statement***

The information disclosure statement filed August 15, 2007 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

### ***Response to Arguments***

Applicant's arguments, see pages 10-13, with respect to Applicant's *Request to Withdraw the Finality of the July 16, 2007 Office Action* have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

Applicant's arguments, see pages 14-24, with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments, see pages 24-26, with respect to claim 17 have been considered but are moot in view of the Examiner's election by original presentation set forth above.

Applicant's arguments, see pages 26-29, with respect to claim 20 have been considered but are moot in view of the Examiner's election by original presentation set forth above.

Applicant's arguments, see pages 29-30, with respect to claims 2-3, 8-9, 11, and 15-16 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments, see pages 29-30, with respect to claims 18-19 and 21-28 have been considered but are moot in view of the Examiner's election by original presentation set forth above.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3, 8-9, 11, and 15-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

application was filed, had possession of the claimed invention. Independent claim 1 includes limitations regarding *"a scan process executing in the memory and being configured to cause a printed document to be scanned at the multi-functional peripheral device and to generate scan data that includes a digital representation of a first electronic document that is based on the printed document"* and *"a print process executing in the memory and bring configured to process print data and cause a printed version of a second electronic document reflected in the print data to be generated by the multi-function peripheral device at the multi-function peripheral device."* The Examiner has conducted a thorough examination of Applicant's specification and is unable to locate any areas within Applicant's original disclosure that might provide for Applicant's detailed "print process" and "scan process." The only mentions of "scanning" and "printing" appear to refer to the scanning and printing capabilities of a multi function peripheral and as such fail to provide the specificity as claimed in Applicant's newly amended claims. The Examiner invites Applicant to point out those specific sections within the specification that provide for the abovementioned claim limitations so that she might reconsider her rejections. Insofar as the remainder of the pending claims is based upon rejected independent claim 1, the Examiner rejects all pending claims for those reasons given above.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **1-3, 8-9, 11, and 15-16** are rejected under 35 U.S.C. 102(e) as being anticipated by United States Patent Application Publication No. 2004/0193895 A1 to *Kaneko*.

As per **claim 1**, Kaneko teaches a multi-function peripheral device comprising:  
a network interface configured to allow the multi-function peripheral device to communicate with network devices over a network (pars 16, 26-28); a graphical user interface configured to allow for the exchange of information between the multi-function peripheral device and a user (pars 22-29); one or more processors (pars 14-15); a memory (pars 28, 94); a scan process executing in the memory and being configured to cause a printed document to be scanned at the multi-function peripheral device and to generate scan data that includes a digital data representation of a first electronic document that is based on the printed document (par 27); a print process executing in the memory and being configured to process print data and cause a printed version of a second electronic document reflected in the print data to be generated by the multi-function peripheral device at the multi-function peripheral device (pars 27, 39, 64, 71); and a virus protection process executing in the memory and being configured to perform the steps of: examine data stored on non-volatile memory of the multi-function



Art Unit: 2137

peripheral device (par 30, 35, 37); based on examining the data, detect that one or more unauthorized instructions are stored on the non-volatile memory of the multi-function peripheral device (pars 30, 37-38); and in response to detecting that the one or more unauthorized instructions have been stored on the non-volatile memory of the multi-function peripheral device: perform one or more actions to address the one or more unauthorized instructions that have been stored on the non-volatile memory of the multi-function peripheral devices and wherein the one or more actions includes rendering the one or more unauthorized instructions inaccessible and unexecutable on the multi-function peripheral device by moving the one or more unauthorized instructions into a protected area of the non-volatile memory (pars 30, 35).

As per **claim 2**, Kaneko teaches the multi-function peripheral device as recited in Claim 1, wherein the virus protection process is configured to detect that the one or more unauthorized instructions have been stored on the multi-function peripheral device by periodically examining, according to specified configuration criteria, data stored on the multi-function peripheral device to determine whether the data has been modified in an unauthorized manner (pars 36-38, 40-42, 72-73).

As per **claim 3**, Kaneko teaches the multi-function peripheral device as recited in Claim 1, wherein the virus protection process is configured to detect that the one or more unauthorized instructions have been stored on the multi-function peripheral device by examining and detecting the modification of data that one or more data files stored

on the multi-function peripheral device, wherein the data is selected from the group consisting of one or more data files, program code, and configuration data have been modified (pars 36-38, 40-42, 72-73).

As per **claim 8**, Kaneko teaches the multi-function peripheral device as recited in Claim 1, wherein the virus protection process is further configured to undo changes made as a result of execution of the one or more unauthorized instructions (pars 85-87).

As per **claim 9**, Kaneko teaches the multi-function peripheral device as recited in Claim 1, wherein the virus protection process is further configured to: determine whether particular data stored on the multi-function peripheral device can be restored to a prior state and in response to determining that the particular data cannot be restored to the prior state, then delete the particular data from the multi-function peripheral device (pars 85-87).

As per **claim 11**, Kaneko teaches the multi-function peripheral device as recited in Claim 1, wherein the virus protection process is further configured to provide a notification user via the graphical user interface on the multi function peripheral device that the storage of the one or more unauthorized instructions on the multi-function peripheral device has been detected, wherein the notification is selected from the group consisting of displaying information on the graphical user interface on the multi-function peripheral device, printing a report on the multi-function peripheral device, sending an

email from the multi-function peripheral device, and sending a facsimile from the multi-function peripheral device (pars 88-89).

As per **claim 15**, Kaneko teaches the multi-function peripheral device as recited in Claim 1, wherein the multi-function peripheral device is configured to receive, over a network, data used by the virus protection process to detect that the one or more unauthorized instructions have been stored on the multi-function peripheral (par 94).

As per **claim 16**, Kaneko teaches the multi-function peripheral device as recited in Claim 1, wherein: the one or more unauthorized instructions are contained in a file stored on a portion of the non-volatile memory (pars 84, 87); the one or more actions includes deleting the file (par 87); and the virus protection process is further configured to, after deleting the file, overwrite the portion of the non-volatile memory with a specified pattern (par 95).

### ***Conclusion***

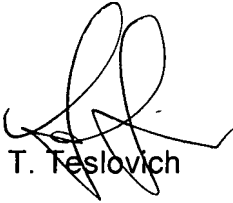
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara Teslovich whose telephone number is (571) 272-4241. The examiner can normally be reached on Mon-Fri 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone

Art Unit: 2137

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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